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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/950,826	10/15/1997	YUKIO UEMURA	4041J-000063	9840

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EXAMINER

FORD, JOHN K

ART UNIT PAPER NUMBER

3743

DATE MAILED: 09/30/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Examiner

Art Unit

08/950826

Nemura et al.

FORD

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 3-11-02 (Petition to withdraw abandonment & proceed to appeal)
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10, 19-24 is/are pending in the application.
- 4a) Of the above claim(s) 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-8, 10, 19-24 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Applicants have successfully petitioned the withholding of abandonment (See Paper Nos. 18 and 19). Applicant's appeal briefs (in triplicate) have been received. Applicants have elected for prosecution the second species identified in Paper No. 4, wherein the post-evaporator sensor 39 is disposed in second passage 14 (i.e. the lower passage). The earliest application in applicants' priority documents to disclose a post-evaporator sensor in the lower passage is JP application 8-340107 filed December 19, 1996 and published as JP 10-175423. That is the earliest priority date (12-19-96) that the full scope of claims 1 and 10 is entitled to. If applicants disagree, state at what earlier date / application and paragraph number in that earlier document, if any, a post-evaporator sensor in the bottom passage is disclosed.

A close inspection of the priority documents JP 08-152721, JP 08-273715, JP 08-340182 and JP 08-340107 show each one has an inventive entity consisting of Kenji Suwa, Yukio Kamimura and Kazufumi Yomo. By contrast, the inventive entity listed on the current file consists of Kenji Suwa, Yukio Uemura and Kazushi Shikata. Is there a reasonable explanation for this discrepancy in inventors? The Examiner can see no possible explanation for omitting inventors Kamimura and Yomo from the current application, given the nearly identical disclosure found in the priority documents versus the disclosure in the current U.S. application SN 08/950,826. As well, the Examiner does not see what possible contribution inventors Uemura and Shikata made to the currently claimed subject matter.

In view of the Appeal Brief filed on March 12, 2002, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

As a preliminary matter applicants election to pursue the appeal is premature. As noted in the final rejection mailed August 10, 2001, page 2, Mr. Suwa's declaration to remove the conceded prior art of Figures 11A-11D was deficient in that it only attested to his own personal knowledge of where the sensor was located in JP 07-047831. He did not speak for the other inventors listed in the priority documents (i.e. Mr. Yomo and Mr. Kamimura). Since the duties under 37 C.F.R. 1.56( c ) run to all of the individuals substantially involved in the preparation or prosecution of the application and who are associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application a declaration by only one of the inventors named in the priority documents (Mr. Suwa) simply isn't reasonably related to the scope of the duty. JP 07-047831 is assigned to Denso. If the JP '831 system was used in a vehicle which was sold in the United States before the earliest priority date applicants are entitled to, then it is prior art and the location of the sensor 80 must be disclosed here.

According to their signed declarations, each of inventors Uemura, Suwa and Shikata reviewed and understood the contents of the as filed SN 08/950826, including "Prior Art" legended Figures 11A – 11D. Moreover US law implies a duty of reasonable investigation of the facts. See In re Brasseler, 267 F.3d 1370 (Fed. Cir. 2001).

In this case, Denso has highly pertinent references in JP 07-047831 and Iritani et al. (USP 5,526,650) and applicants in the Brief stay entirely within the four corners of the references without making any reasonable inquiry of the inventors of JP 07-047831 or Iritani et al. (which inventors are all employees of the assignee, Denso) as to the actual location of the post-evaporator sensor in the ducts of JP '831 or Iritani et al. Make a reasonable inquiry consistent with the guidance set forth in Brasseler and report the results in the next response by applicants.

Because only one inventor (and not all of the inventors) signed the declaration it is deemed insufficient to remove the admitted prior art of Figures 11A-11D. The declaration also did not have the proper penalty clause. See MPEP 715.04 and MPEP 604-604.06 and 37 CFR 1.68.

Finally, the Examiner recently discovered JP 61-202914, assigned to Denso which clearly discloses a post-evaporator sensor 6 in the lower duct.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

Claims 1, 3-8, 10 and 19-24 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

JP 10-175423 discloses that the inventors of this invention were Messrs. Suwa, Kamimura and Yomo, not the current inventive entity of Messrs. Suwa, Uemura and Shikata. Please explain how these latter inventors are the actual inventors of this device and why, if they are not the actual inventors, they signed declarations that they were the inventors.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, 7, 8, 10, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iritani et al. (USP 5,526,650) in view of JP 6-40249

Iritani shows a "double-layer" air conditioning device as admitted in applicants' Appeal Brief of March 12, 2002 (Paper No. 17, page 9) and has a post-evaporator

temperature (Te) sensor 80 disclosed. Moreover, and this is not discussed in the Appeal Brief of March 12, 2002, an evaporator target (set) temperature, Teo, is calculated (Box 230 in Figure 12B) as disclosed in col. 10 lines 5-13. By adjusting the "revolving speed" of the compressor 56, the evaporator exit temperature (Te) is compared to the evaporator target (set) temperature (Teo) and "because the foregoing evaporator target exit temperature Teo" (col. 10, lines 9-13). The target (set) temperature Teo is apparently varied "for example the intake air temperature Tin (15 C and also 3 C or over)" (col. 10, lines 6-8). Tin is the temperature of the air taken into the evaporator (col. 8, lines 63-64), which must be at least a function of outdoor air temperature, inherently (see page 21 lines 11-14 of the translation of JP 7-47831, for example). Thus, in regard to claim 1, the change in evaporator target (set) temperature Teo is, in the example given, made according to the temperature of outside air (since Tin must inherently be influenced by outside air temperature).

With regard to even broader claim 10 the adjusting means and adjusting control means (i.e. compressor speed control system described above) are clearly disclosed.

In Iritani, the single deficiency, in regard to claims 1 and 10, is that it does not specify the exact location of the post-evaporator temperature sensor 80, but it inherently must be placed in either the upper or lower duct as evidenced by applicant's Figures 11A-11D.

Placement of a post-evaporator temperature sensor 6 in the bottom duct P2 of a split type air conditioner casing is fairly taught in JP 61-202914 assigned to Denso and recently discovered by this Examiner.

To have located sensor 80 of Iritani in the bottom duct (i.e. below partition 32 and downstream of evaporator 31) in the manner taught JP 61-202914 would have been obvious to one of ordinary skill for any number of reasons, including, but not limited to, the relatively easy access to this sensor for replacement when the system is installed in a conventional automobile. Typically, the bottom of an air conditioner casing can be reached under the dashboard without any significant disassembly whereas the top of an air conditioner casing requires significant, labor intensive, disassembly of the unit and/or dashboard.

Claims 3 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claims 1 and 10 above, and further in view of JP 6-270645 or JP 7-69045.

JP'645 and JP '045 each teach decreasing the evaporator temperature as the outdoor temperature goes down to permit low humidity air to be generated by the evaporator to aid in removing mist from the windshield glass.



To have used such an algorithm in Iritani '650 (discussed above) to advantageously improve demisting performance in cold weather (without unduly consuming excessive energy at higher outdoor temperatures) would have been obvious to one of ordinary skill.

Claims 6,19,23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claims 1 and 10 above, and further in view of JP 5-124426.

JP'426 teaches the subject matter claimed in claims 6,19, 23 and 24 in a "double-layer" system. To have configured the Iritani system with fresh/recirculation ducts at both inlet fans and a downstream deflector (31) as shown in JP'426 would have been obvious to improve conditioning performance.

Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. *(assuming the 102(f) rejection can be overcome)*.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to John K Ford at telephone number 703-308-2636.



**John K Ford**  
**Primary Examiner**